



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re the Patent Application of:)
)
Erik T. Donhowe)
)
Serial No.: 10/047,411) Art Unit: 1761
)
Filed: January 16, 2002)
) Examiner: Sherrer, Curtis
For: Product and process of making an)
alcohol containing sport drink)
)
)
)
)

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

10/14/2004 MAHMED1 00000023 502808 10047411
01 FC:2402 170.00 DA

Serial No. 10/047,411

APPEAL BRIEF
IN SUPPORT OF APPELLANT'S APPEAL
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Sir:

Applicant (hereafter "Appellant") hereby submits this Brief in triplicate in support of its appeal from a final decision by the Examiner, mailed 04/13/2004, in the above-captioned case. Appellant respectfully requests consideration of this appeal by the Board of Patent Appeals and Interferences for allowance of the above-captioned patent application.

An oral hearing is not desired.

TABLE OF CONTENTS

- I. REAL PARTY IN INTEREST
- II. RELATED APPEALS AND INTERFERENCES
- III. STATUS OF THE CLAIMS
- IV. STATUS OF AMENDMENTS
- V. SUMMARY OF THE INVENTION
- VI. ISSUES PRESENTED
- VII. GROUPING OF CLAIMS
- VIII. ARGUMENT
- X. APPENDIX OF CLAIMS

I. REAL PARTY IN INTEREST

The inventor, Erik T. Donhowe, is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

This appeal may be directly affected by a concurrently filed Appeal for patent application 10/078,207 filed on 02/20/2002 entitled "Product and process of making a protein, vitamin, mineral and antioxidant fortified sport beer", which has the same inventor and real party in interest as the subject of this Appeal Brief.

III. STATUS OF THE CLAIMS

Claims 16-35 are currently pending in the above-referenced application. Claims 29-32 were withdrawn from consideration and are not the subject of this appeal. Claims 16-28 & 33-35 were rejected in the Final Office Action mailed 04/13/2004, and are the subject of this Appeal.

Claims 16-28 & 33-35 stand rejected under 35 U.S.C. 112, second paragraph as being Indefinite. Further, claims 17-20, 23 & 34 also stand rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement.

Additionally, one or more claims were rejected under 35 U.S.C. 103(a) as being unpatentable over the Applicant's Admissions in view of Pass The Gas (www.danchan.com/weblog/PassTheGas/73041), which as indicated by the Examiner contains a reprint of a 1977 article from Oui magazine. However, the Examiner failed to specifically indicate which claims were rejected under 35 U.S.C. 103(a). Further, the web address provided as prior art does not exist, and

no copy of the prior art contained on the web site was provided. Accordingly, for purposes of this Appeal, the Appellant will assume the Examiner intended to reject all pending claims under 35 U.S.C. 103(a), and that the relied upon content of the Pass The Gas reference is limited to that disclosed by the Examiner in the Final Office Action.

IV. STATUS OF AMENDMENTS

In response to the Final Office Action mailed on 04/13/2004, Appellant filed a timely a Notice of Appeal.

A copy of all claims on appeal is attached hereto as an Appendix of Claims.

V. SUMMARY OF THE INVENTION

One embodiment of the Invention describes an alcoholic beverage that contains nutritional supplementation including protein in non-trivial concentrations. *See Appellant's Specification, pg 1, Background of the Invention, paragraph 1, and pg 3, Brief Summary of the Invention, paragraph 1.* Despite the addition of the nutritional supplements, the one embodiment retains the color, taste and appearance of unsupplemented alcoholic beverages. *See Appellant's Specification, pg 3, Brief Summary of the Invention, paragraph 1.*

One embodiment of the beverage contains 3.3-50 grams/liter of hydrolyzed protein in addition to water, ethyl alcohol and 10%-100% of the FDA Daily Value guidelines of Vitamin C. The beverage is both clear and translucent. Additional, supplements can be included in variations, such as (i) Vitamins A, B1, B2, B6, B12 and E, iron, zinc and calcium. Additionally, variations can include carbonation and supplemental flavor additives. *See generally Appellant's Specification, pgs 4-8.*

VI. ISSUES PRESENTED

Issue 1 - Whether one or more of the pending claims are unpatentable under 35 U.S.C. 103(a) over the Applicant's Admissions in view of Pass The Gas (www.danchan.com/weblog/PassTheGas/73041)

Issue 2 - Whether claims 17, 19, 20, 23 & 34 fail to comply with the written description under 35 U.S.C. 112, first paragraph.

Issue 3 - Whether claims 16-28 & 33-35 are indefinite under 35 U.S.C. 112, second paragraph.

VII. GROUPING OF CLAIMS

For each ground of rejection the Appellant contest herein that applies to more than one claim, such additional claims, to the extent separately identified and argued below, do not stand and/or fall together.

VII. ARGUMENT

Issue 1 - Whether one or more of the pending claims are unpatentable under 35 U.S.C. 103(a) over the Applicant's Admissions in view of Pass The Gas (www.danchan.com/weblog/PassTheGas/73041)

35 U.S.C. Section 103 states:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The Commissioner for Patents through the examiner bears the initial duty of supplying a factual basis supporting a rejection of a patent application including the rejection of the application's claims based on obviousness. *See 35 U.S.C. 132; and see also In re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992).*

The law is well settled that for the examiner to meet the initial duty specifically concerning obviousness, he/she must present a prima facie case of

obviousness. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984); and see e.g. *Ex parte Skinner* 2 USPQ 2d 1788, 1788-89 (B.P.A.I. 1987).

The Federal Circuit has laid down three very specific criteria that must be met to establish a prima facie case of obviousness. First, the prior art reference(s) must teach or suggest all the claim limitations. See *In re Royka*, 490 F.2d 981 (CCPA 1970). Second, There must exist within the prior art a motivation to combine or modify prior art references. See *In re Kotzab*, 217 F.3d 1365, 1370 (Fed Cir. 2000). Finally, there must be a reasonable likelihood of success that any combined or modified prior art will produce the claimed invention. See *In re Merck*, 800 F.2d 1091 (Fed. Cir. 1986).

The Applicant respectfully submits that the Examiner has not made a prima facie case of obviousness concerning any of the pending claims. For purposes of this issue only, Claims 17-28 & 34-35 fall with their respective independent Claims 16 and 33, but as individually identified herein concerning this issue stand separately from their respective independent claim. Specifically, the reference(s) cited by the Examiner fail to teach or suggest all of the limitations of each claim. Accordingly, for at least this reason the Examiner has failed to present a prima facie case of obviousness concerning any of the pending claims.

Rather, to counter any deficiencies in the satisfaction of the prima facie obviousness criteria, the Examiner chose to improperly rely upon *In re Levin*, a Court of Customs and Patent Appeals dating to December 12, 1949 that established a per se rule concerning food product inventions. 84 USPQ 232 (CCPA 1949). The case, however, was decided on inventiveness, a standard that was supplanted by the obviousness standard with the passage of 35 U.S.C. 103 in

1952 and accordingly, is inapposite to the obviousness rejections in this case. In this regard, *In re Levin* is no longer applicable law concerning patentability.

Specifically, *In re Levin* provides a per se rule concerning the patentability of food stuffs. *Id.* at 234. Perhaps, this rule was necessary in the pre 35 U.S.C. 103 days of patent law, but since then the courts have clearly indicated the only basis for denying patentability to a useful invention is the lack of novelty or obviousness as specifically described in the 35 U.S.C. 102 and 35 U.S.C. 103. Relatively recent cases concerning software, business methods, and living organisms expound on the proper manner of determining patentability and eschew the use of judicially created exceptions to the proper and required application of 35 U.S.C. 102 and 103. See generally *AT&T v. Excel Communications Inc.*, 172 F.3d 1352 (Fed. Cir. 1999); *State Street Financial v. Signature Financial*, 149 F.3d 1368 (Fed. Cir. 1998); and *In re Chakrabarty*, 447 U.S. 303 (1980). Even more directly on point, the Federal Circuit made it very clear in 1995 that there are no per se rules when determining obviousness under 35 U.S.C. 103. *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995). Accordingly, the Examiner's reliance on this case is a misplaced substitute for presenting a proper prima facie case of obviousness.

Although not binding precedent but definitely persuasive, this Board has also weighed-in specifically concerning the per se rule of *In re Levin* and food stuffs in *Ex parte Earl L. Johnson*. Appeal No. 1997-2565 (BPAI). This case is also very illuminating in so much as the subject invention relates to a beverage, and in many respects the rejection proffered by the examiner in that case is nearly the same as the rejection put forth in the present case on appeal. Essentially, the examiner made a rejection of a drink consisting of orange juice and tomato juice concentrate with added preservatives. The examiner relied upon reference that

teaches combining tomato and orange juice along with mint leaves, sugar, and lime juice in combination with two references that teach adding preservatives to foods including citrus juices. The examiner apparently dismissed the need to consider the differences between the claimed beverages and the relied upon references despite the fact the beverage was claimed using “consisting essentially of” language. *Id.* at 2-3. Rather in her answer to the appeal, the examiner stated, “nothing new or unexpected is seen in varying the amounts of ingredients” and called attention to *In re Levin* and printed the following paragraph from that case:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected, and useful function. *In re Benjamin D. White*, 17 C.C.P.A. (Patents) 956, 39 F.2d 974, 5 USPQ 267; *In re Mason et al.*, 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221.

Id. at 5 (citing *In re Levin* at 234). This very same paragraph was cited by the Examiner in the present case in support of his obviousness rejection.

The Appellant in *In re Earl Johnson* presented two arguments: (1) The examiner improperly applied *In re Levin* as a per se rule; and (2) the relied upon references did not teach the claimed invention. *Id.* Essentially, the same arguments are presented herein. The Board agreed with the appellant and firmly stated "...there are no per se rules when determining obviousness under 35 U.S.C. section 103." *Id. at 6-7.* To support that position the board quoted *Ochiai*:

The use of per se rules, while undoubtedly less laborious than a searching comparison of the claimed invention-including all its limitations with the teachings of the prior art, flouts section 103 and the fundamental case law applying it. Per se rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO examiners and the Board. Indeed, they have been sanctioned by the Board as well. But reliance on per se rules of obviousness is legally incorrect and must cease. Any such administrative convenience is simply inconsistent with section 103, which, according to *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966)] and its progeny, entitles an applicant to issuance of an otherwise proper patent unless the PTO establishes that the invention as claimed in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations. We once again hold today that our precedents do not establish any per se rules of obviousness, just as those precedents themselves expressly declined to create such rules. Any conflicts as may be perceived to

exist derive from an impermissible effort to extract per se rules
from decisions that disavow precisely such extraction.

Id. at 7 (citing *Ochiai* at 1572). Emphasis added. The Board then paraphrased the court in *Ochiai*, at 71 F.3d at 1570, 37 USPQ2d at 1132, there are not [Levin] obviousness rejections . . . but rather only section 103 obviousness rejections. *Id.* Emphasis added. The present Appellant agrees completely with the Board's findings concerning per se rules.

Next, the Board discussed the standard to be used by an examiner in making a prima facie case of obviousness. They commented that an examiner must explicitly address the *Graham v. John Deere Co.* criteria. *See* 383 US 1 (1966). The Board added "In addition, care must be exercised in citing caselaw predating *Graham v. John Deere*". *Ex parte Earl Johnson* at 8. Ultimately, since the reference relied upon by the examiner in this case did not teach the same combination of elements as the claimed beverage, the Board reversed the examiner's rejections. *Id.* at 11.

As stated above, the Examiner of the present application Appeal failed to provide references that teach and suggest each and every limitation in each claim. The Federal Circuit has indicated that in order for it to review a decision by the Board of Patent Appeals and Interferences and the USPTO, the Board must provide administrative record showing the evidence on which the findings are based, accompanied by the agency's reasoning and reaching its conclusions. *See In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). Such a requirement can be applied to an examiner as well, since the Board will not be able to make an informed and reasoned decision without an adequate record from an examiner.

A. Concerning Claim 16, the references relied upon by the Examiner fails to teach or suggest directly or implicitly the use of "hydrolyzed protein" in the specified concentration. In fact, the only thing that can be gleaned from the Examiner's reference is that Arnold Schwartznagger at least once spiked a protein shake with vodka. Proteins used in protein shakes typically comprise insoluble whey protein that has not been hydrolyzed. No evidence has been presented indicating the protein in the shake of the Examiner's reference was any different from other protein shakes. In fact, the term "shake" typically implies a relatively fixed opaque beverage, which often indicates the presence of insoluble solids (i.e. insoluble protein) contained in suspension.

Further, the references relied upon by the Examiner fail to teach or suggest directly or implicitly the use of Vitamin C in alcoholic beverage in the required concentration. No evidence has been presented that the protein shake of the Examiner's reference contains Vitamin C.

Apparently, the Examiner has taken official notice as to the presence of hydrolyzed protein and Vitamin C in the required concentrations in the reference's protein shake. However, the Appellant wrote in the first Office Action response:

If in fact it was the Examiner's intent to take judicial notice of: (1) the existence of non-brewed alcoholic beverages; (2) the nutrients not provided for in the required quantities in the Lux reference; and (3) the knowledge of adding these nutrients to an alcoholic beverage, than the applicant traverses such assertions and requests the Examiner provide a citations to support his position. *See MPEP 2144.03.*

Despite this traverse, the Examiner failed to provide the necessary evidence. *See* 37 CFR 104(C)(2).

For at least the reasons provided above, the Examiner has failed to present a valid prima facie case of obviousness concerning Claim 16 and its dependent claims.

B. Concerning Claim 17, nothing in the spiked vodka protein shake reference teaches or suggests that the various listed vitamins are contained in the shake in the required concentrations. Accordingly, for at least this reason, the Examiner has failed to present a valid prima facie case of obviousness concerning Claim 17.

C. Concerning Claim 20, nothing in the spiked vodka protein shake reference teaches or suggests that the hydrolyzed protein comprises rice protein. Accordingly, for at least this reason, the Examiner has failed to present a valid prima facie case of obviousness concerning Claim 20.

D. Concerning Claim 21, nothing in the spiked vodka protein shake reference teaches or suggests that Vitamin E or selenium are contained in the shake in the required concentrations. Accordingly, for at least this reason, the Examiner has failed to present a valid prima facie case of obviousness concerning Claim 21.

E. Concerning Claim 22, nothing in the spiked vodka protein shake reference teaches or suggests that one or more of iron, calcium or zinc are contained in the shake in the required concentrations. Accordingly, for at least this reason, the Examiner has failed to present a valid prima facie case of obviousness concerning Claim 22.

F. Concerning Claim 23, nothing in the spiked vodka protein shake reference teaches or suggests that peppermint flavoring is contained in the shake. Further, nothing in the reference suggests or teaches that the alcohol content of the shake after being spiked with vodka would be 40%. Accordingly, for at least these reasons, the Examiner has failed to present a valid prima facie case of obviousness concerning Claim 23.

G. Concerning Claim 24, nothing in the spiked vodka protein shake reference teaches or suggests flavoring the shake with one or more of the listed flavor extracts. Accordingly, for at least these reasons, the Examiner has failed to present a valid prima facie case of obviousness concerning Claim 24.

H. Concerning Claim 26, nothing in the spiked vodka protein shake reference teaches or suggests that supplemental caffeine is contained in the shake in the required concentrations. Accordingly, for at least this reason, the Examiner has failed to present a valid prima facie case of obviousness concerning Claim 26.

I. Concerning Claim 27, nothing in the spiked vodka protein shake reference teaches or suggests that the beverage is carbonated. Accordingly, for at least this reason, the Examiner has failed to present a valid prima facie case of obviousness concerning Claim 27.

J. Concerning Claim 28, nothing in the spiked vodka protein shake reference teaches or suggests that one or more buffering agents from the provided group are contained in the shake. Accordingly, for at least this reason, the Examiner has failed to present a valid prima facie case of obviousness concerning Claim 28.

K. Concerning Independent Claim 33, nothing in the spiked vodka reference suggests a concentration of hydrolyzed protein of 3.3 to 50 grams per liter. Nothing in this reference suggests that the beverage be either clear or translucent. Accordingly, for at least these reasons, the Examiner has failed to present a valid prima facie case of obviousness concerning Claim 33.

L. Concerning Independent Claim 34, nothing in the spiked vodka reference suggests a concentration of Vitamin C in the required concentration. Accordingly, for at least these reasons, the Examiner has failed to present a valid prima facie case of obviousness concerning Claim 34.

M. Concerning Claim 35, nothing in the spiked vodka protein shake reference teaches or suggests that the beverage is carbonated. Accordingly, for at least this reason, the Examiner has failed to present a valid prima facie case of obviousness concerning Claim 35.

Issue 2 - Whether claims 16-20, 23 & 34 fail to comply with the written description under 35 U.S.C. 112, first paragraph.

The fundamental factual inquiry concerning the written description requirement is whether the originally filed specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, the applicant was in possession of the invention as now claimed. *Vas-cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed Cir. 1991). The originally filed claims are considered part of the originally-filed specification. *See In re Koller*, 613 F.2d 819 (CCPA 1980).

A. Concerning Claim 17, the Examiner asserts that no written description support is provided for the range of 10%-100% of the United States Food and

Drug Administration's Daily Value(DV) for Vitamins B2, E, B1, B6 and A. The originally filed specification states in the first paragraph of page 4:

The beverage described in this invention is clear and translucent, and is composed of 60% to 99.5% water by volume, 0.45% to 40% ethyl alcohol by volume, 3.3 to 50 grams/liter, 0.1 to 50 grams/liter buffers, 3.3 to 50 grams grams/liter minerals (iron, calcium and zinc), 0.01 mg/liter to 1 grams/liter antioxidants (Vitamin C, Vitamin E and selenium, 10% to 100% of U.S. Recommended Daily Value of vitamins (Vitamin A, Vitamin E, Vitamin C, Vitamin B1, Vitamin B2, Vitamin B6, and Vitamin B12), and flavor extract.

Simply, the stated section of the specification provides direct incontrovertible written description support for claim 17.

B. Concerning Claims 19 and 20, the Examiner asserts that the specification fails to support for the requirement that the whey or soy of Claim 19, or the rice protein of Claim 20 be hydrolyzed. Specifically, Claim 19 recites "...the hydrolyzed protein comprises one or soy or whey". Claim 20 recites, "...the hydrolyzed protein comprises rice protein."

Hydrolyzed protein is protein that has been processed via hydrolysis to break the protein down into smaller molecules. As known to those skilled in the art, one of the primary advantages offered by hydrolyzed protein over unhydrolyzed protein is its much greater solubility in water. The use of hydrolyzed proteins is indicated in several places in the as-filed specification; namely, the list of the composition of Example 1 on page 5 and the list of the composition of Example II on page 5.

The specification implicitly indicates need to use the soluble protein in several places in the specification by mentioning the resulting beverage is "clear/translucent" in paragraph 5 on page 3, and the as-filed Claims 1 & 15, which were canceled. It is known by those of ordinary skill in the art that a beverage containing the required concentrations of insoluble protein would not be either clear or translucent but substantially opaque. The proteins listed in the referenced claims are typically insoluble in water unless processed to increase their solubility. The specification only mentions one process that is suitable for substantially increasing the solubility of protein in water, namely, hydrolyzation with the phrase "hydrolyzed protein" in the lists of Examples I and II.

Support for the use of the various different types of protein is provided in Claim 4 of the as-filed application, which has been since canceled. Specifically Claim 4 states, "...the supplemental protein consists of whey, casein, soy protein, rice protein, albumin, hydrolyzed protein and/or highly branched chain amino acids." The use of the "and/or" conjunction in the claim clearly indicates anyone one protein type could be used by itself or in any suitable mixture of the listed elements.

As stated above, the relevant inquiry concerning section 112, first paragraph is whether the applicant was in possession of the invention as now claimed at the time of filing. The Appellant clearly anticipated the use of any one of the listed proteins alone or in combination with each other. The Appellant implicitly indicated that the protein in the resulting beverages soluble by indicating the beverage be clear or translucent. The Appellant indicated that the protein used in the Examples be hydrolyzed. Since the various types of proteins indicated in the specification and the pending claims are not soluble in water, it

would be undoubtedly clear to someone of ordinary skill in making beer that the Appellant at the time of filing intended any protein including those indicated in the claim to be made soluble using the process of hydrolyzation.

C. Concerning Claim 23, the Examiner asserts the specification does not provide support for the phrase "about 40%" in reference to the amount of ethyl alcohol in the claim beverage. The composition of Example 3 on page 6 lists "Ethyl Alcohol" 40% in reference to a beverage further containing peppermint flavoring as also required by the claim. Accordingly, the as-filed specification provides written description support for this limitation.

D. Concerning Claim 34, the Examiner asserts the specification does not provide support for the phrase "about at least 25%" as it relates to the USDA's Recommended Daily Value percentage of Vitamin C in the claimed beverage. First, the pertinent phrase as it appears in Claim 34 is "about 25%" not "at least about 25%". The specification on page 5, second paragraph specifically states about Example 1, "the beverage has ... vitamins at 25% of the RDA values." The composition of the vitamins that can comprise the beverage recited in the specification specifically includes Vitamin C. *See Appellant's Specification, pg 4, paragraph 1.* Accordingly, the as-filed specification provides written description support for this limitation.

Issue 3 - Whether claims 16-28 & 33-35 are indefinite under 35 U.S.C. 112, second paragraph.

A. Concerning Claims 17, 23 & 34, the Examiner asserts they are indefinite “because the scope of the term ‘about’ is unknown”. The Federal Circuit Court of Appeals has found that the term “about” does not generally render a claim indefinite. *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1557 (Fed. Cir. 1983). “About” is not an arbitrary term, but rather a flexible word with a meaning similar to “approximately” or “nearly”. *Ex parte Eastwood*, 163 USPQ 316,317 (Pat. Off. Bd. App. 1968). The term about when used in conjunction with a numerical quantity can normally be interpreted to encompass a range of values within the scientific convention of rounding. *Viskase Corporation v. American National Can Co.*, 261 F.3d 1316 (Fed. Cir. 2001). Accordingly, as used herein the term “about” can be interpreted likewise and is not indefinite.

B. Concerning claims 16 and 33, the Examiner contends they are indefinite the scope of the phrases “substantially clear” and “substantially translucent” are unknown. Specifically, the Examiner wrote, “it is not clear how these two phrases describe separate subject matter”.

The term “clear” when used in terms of a liquid or beverage typically describes a beverage that has no coloration, i.e. “clear water” or “PepsiClear™”. In contrast, “translucent” is used to refer to a liquid or beverage that permits light to pass therethrough but the light is in some way altered or hindered. For instance, the light may be diffused somewhat or certain wavelengths of light may not be able to pass through a translucent beverage. An example of a translucent beverage would be Kool-Aide™, which is typically will not allow light of a wavelength the same as the color of the beverage pass therethrough but will

allow all other wavelengths to pass. Accordingly, the terms are not indefinite in the sense that they do identify separate subject matter.

Further, even if for sake of argument, one assumes that "clear" and "translucent" have the same meaning, it is not clear to the Appellant how this makes either claim indefinite. Specifically, claim 16 states, "the beverage is one of substantially clear and substantially translucent." Assuming the terms to the same meaning, the referenced wherein clause would be grammatically awkward, but it would not present a problem in ascertaining the scope of the claim.

VII. CONCLUSION

The References relied on by the Examiner fail to teach, suggest or motivate all of the elements of either Claims 16 & 33 or any of their dependent claims of the Appellant's application. The vodka spiked protein shake reference does not teach many of the limitations of the various claims including but not limited to the use of hydrolyzed protein and the inclusion of Vitamin C in the beverage. Further, the reliance on *In re Levin*, a case decided prior to the passage of 35 U.S.C. 103, is misplaced as the courts have made it abundantly clear no per se rules may be used in making an obviousness determination.

The Examiner's 35 U.S.C. 112, first and second paragraph rejections are in error. Concerning the written description rejections, the necessary support is provided in the as-filed specification as specifically indicated supra. Concerning the indefiniteness rejections, the term "about" used in several of the claims has not been found to be inherently indefinite by the Federal Circuit. Further, the term "clear" and "translucent" are not synonyms as the Examiner seems to assert and accordingly the claims reciting both are not indefinite.

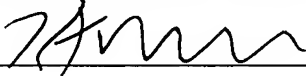
Appellant respectfully submits that all the appealed claims in this application are patentable and requests that the Board of Patent Appeals and Interferences overrule the Examiner and direct allowance of the rejected claims.

This brief is submitted in triplicate, along with a check for \$165.00 to cover the appeal fee for a small entity as specified in 37 C.F.R. § 1.17(c) and the fee for a month extension for response. Please charge any shortages and credit any overcharges to our Deposit Account No. 502808.

7
Date: OCTOBER ~~8~~ 2004

Respectfully submitted,

LEYENDECKER LEMIRE & DALEY, LLC



Kurt Leyendecker

Attorney for Appellant

Registration Number: 42,799

LEYENDECKER LEMIRE & DALEY, LLC

16A Inverness Place East

Englewood, CO 80126

(303) 768-0644

APPENDIX OF CLAIMS (37 C.F.R. § 1.192(c)(7))

1-15. (canceled)

16. (Pending) An 1 non-brewed beverage comprising:

60% to 99.5% water by volume;

0.45% to 40% ethyl alcohol by volume;

3.3 grams to 50 grams per liter concentration of hydrolyzed protein;

10%-100% of the United States Food and Drug Administration's

Daily Value (DV) amount of vitamin C in a serving; and

wherein the beverage is one of substantially clear and substantially translucent.

17. (Pending) The non-brewed beverage of claim 16, further comprising vitamin B2, vitamin E, vitamin B1, vitamin B6, vitamin B12, and vitamin A each at amounts in a serving between about 10% and 100% of the United States Food and Drug Administration's Daily Value (DV).

18. (Pending) The non-brewed beverage of claim 16, wherein the hydrolyzed protein comprises high branched chain amino acids.

19. (Pending) The non-brewed beverage of claim 16, wherein the hydrolyzed protein comprises one of whey or soy.

20. (Pending) The non-brewed beverage of claim 16, wherein the hydrolyzed protein comprises rice protein.
21. (Pending) The non-brewed beverage of claim 16, further comprising 0.01 mg to 1 grams per liter of vitamin E or selenium.
22. (Pending) The non-brewed beverage of claim 16, further comprising a concentration 0.01% to 0.5% by weight of one or more of iron, calcium and zinc.
23. (Pending) The non-brewed beverage of claim 16, further comprising peppermint flavoring and wherein the ethyl alcohol concentration is about 40%.
24. (Pending) The non-brewed beverage of claim 16, further comprising flavor extracts of one or more of the following: lemon; orange; grapefruit; lime; peach; guava; apple; cranberry; blueberry; grape; pineapple; cherry; strawberry; mango; papaya; peppermint; cinnamon; carrot; tomato; liquorice; coffee and coca.
25. (Pending) The non-brewed beverage of claim 16, further comprising one or more of the following: fructose; corn syrup; sucrose; honey; glucose; sucralose; aspartame and stevia.
26. (Pending) The non-brewed beverage of claim 16, further comprising supplemental caffeine in concentrations of 0.01% to 0.5% by weight.

27. (Pending) The non-brewed beverage of claim 16, wherein the beverage is carbonated with CO₂ gas.
28. (Pending) The non-brewed beverage of claim 16, further comprising one or more buffering agents from the group of: citric acid; tartaric acid; malic acid; succinic acid; ascorbic acid; phosphoric acid; potassium phosphate and sodium phosphate.
29. (Withdrawn From Consideration) A beverage produced by: mashing a pale malt grain; boiling the clarified malt extract to create a wort; clarifying and aerating the wort; fermenting and aging the wort to create a pale beer; mixing and dissolving whey protein, vitamin concentrate including vitamin C, ascorbic acid antioxidant, and buffering agents into filtered water; and blending the water mixture to the pale beer.
30. (Withdrawn From Consideration) The beverage of claim 29 having a protein content of at least 1.2 grams per 12 fluid ounces.
31. (Withdrawn From Consideration) The beverage of claim 29 having amounts of vitamin C and vitamin A of about at least 25% of the United States Food and Drug Administration's Daily Value (DV) in a serving.
32. (Withdrawn From Consideration) The beverage of claim 29 having an alcohol content of 3-5% by volume.
33. (Pending) A beverage comprising alcohol in a concentration of 0.45% to 40%, and hydrolyzed protein in a concentration of 3.3 to 50 grams per

liter, wherein the beverage is one of substantially clear and substantially translucent.

34. (Pending) The beverage of claim 33, further comprising vitamin C in an amount of about 25% of the United States Food and Drug Administration's Daily Value (DV) in a serving.

35. (Pending) The beverage of claim 33, wherein the beverage is carbonated.